

REMARKS

Claims 1-22 are pending in the present application. By this Amendment, claim 1 is amended. Claims 1, 14 and 19 are independent claims.

Objection to the Specification

The Examiner objected to the specification due to minor informalities. In particular, the Examiner states that the Amendment filed on November 1, 2004 failed to include page 2 which contained the amendments to the specification.

Applicants submit that the amendments now obviate the objection. Withdrawal of the objection is respectfully requested.

35 U.S.C. § 102(b) - Garrett rejection

Claims 14-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Garrett, Sr. et al. (hereinafter "Garrett"), USP 4,285,433. This rejection is respectfully traversed.

The Examiner asserts that *intended use* of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claims. However, Applicants submit that there is nothing inherently wrong with defining some part of an invention in functional terms, *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). In fact, MPEP 2173.05(g) states "A functional limitation must be evaluated and considered, just like any other limitation of the claims, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is

served by the recited element, ingredient or step” (Emphasis added). Accordingly, the functional limitation of “causing the release tape to be attached to the protective tape portion and, once bonded, to separate the protective tape portion from the protected surface of the individual chip, while the individual chip is attached to a chip pad”, as recited in claim 14, sets forth definite boundaries on the patent protection sought, and thus must be evaluated and considered.

Accordingly, Applicants submit that claim 14 and those claims dependent thereon are allowable over the prior art. Withdrawal of this rejection is kindly requested.

35 U.S.C. § 102(b) - Farnworth rejection

Claims 19-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Farnworth et al. (hereinafter “Farnworth”), USP 6,202,292. This rejection is respectfully traversed.

As similarly discussed above with regard to independent claim 14, the functional limitation of “removing the protective tape portion from the protected surface, while the individual chip is attached to a chip pad”, as recited in claim 19 must be evaluated and considered.

Accordingly, Applicants submit that claim 19 and those claims dependent thereon are allowable over the prior art. Withdrawal of this rejection is kindly requested.

35 U.S.C. § 102(e) - Kawakami rejection

Claims 1-3, 5-6 and 8-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kawakami, USP 2003/0190795. This rejection is respectfully traversed.

From the comments provided by the Examiner on page 11 in the Office Action, it appears that the Patent Office has not received a verified English translation of the Korean priority document (KR 2002-82672 filed on December 23, 2002). However, Applicants

submit that a copy of a verified English translation of the Korean counterpart patent application was filed along with the August 8, 2004 Amendment.

Nonetheless, Applicants have provided another copy of the verified English translation of the Korean counterpart patent application (KR 2002-82672) filed on December 23, 2002 which is prior to the filing date of Kawakami.

Accordingly, Applicants submit that Kawakami is not valid prior art under 35 U.S.C. § 102. Withdrawal of this rejection is kindly requested.

35 U.S.C. § 103(a) – Yamada/Huang

Claims 1-6, 8-11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada et al. (hereinafter “Yamada”), USP 6,297,131 in view of Huang et al. (hereinafter “Huang”), USP 6,650,006. This rejection is respectfully traversed.

Yamada and Huang, individually or in combination, fail to disclose or suggest, the individual chip is attached to the chip pad before the protective tape portion is removed, as recited in claim 1.

Yamada discloses the chip to be attached to a substrate after the adhesion is reduced and/or after the tape is removed. See Figs. 8-10.

Similarly, Huang discloses attaching the individual chip to the chip pad after the individual chip is formed, rather than during an assembly of the chip, as recited in independent claim 1.

Applicant submits that claim 1 and those claims dependent thereon are allowable over the prior art. Withdrawal of this rejection is kindly requested.

35 U.S.C. § 103 – Yamada/Huang/Oka

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada and Hwang and further in view of Oka, USP 2002/0048904. This rejection is respectfully traversed.

Applicants submit that at least for the reasons as stated above with regard to claim 1, that claim 7 is also allowable over the prior art.

Accordingly, Applicants submit that, for at least the reasons stated above, claim 7 is allowable over the prior art. Withdrawal of this rejection is kindly requested.

CONCLUSION

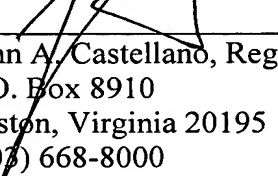
Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-22 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By 
John A. Castellano, Reg. No. 35,094
P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

JAC/DJC/krf

Attachment: Copy of Verified English Language Translation
of Korean Patent Application No. 02-82672